



# UNITED STATES PATENT AND TRADEMARK OFFICE

A

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,391	07/26/2001	Kenneth L. Davis	30566.157-US-01	6276

22462 7590 10/03/2005

GATES & COOPER LLP  
HOWARD HUGHES CENTER  
6701 CENTER DRIVE WEST, SUITE 1050  
LOS ANGELES, CA 90045

EXAMINER
----------

ROSWELL, MICHAEL

ART UNIT	PAPER NUMBER
----------	--------------

2173

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

/

<b>Office Action Summary</b>	Application No. 09/916,391	Applicant(s) DAVIS, KENNETH L.	
	Examiner Michael Roswell	Art Unit 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

HT

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Microsoft Windows NetMeeting 3", <http://www.microsoft.com/windows/NetMeeting/Features/default.asp>, hereinafter NetMeeting, and Schilit et al (US Patent 6,687,876), hereinafter Schilit.

Regarding claims 1 and 20, NetMeeting teaches receiving, in a first client, an identification of a second client to initiate a chat session with, initializing a chat session across a network between the first client and the second client, displaying a graphical image on the first client (all taught as part of the video and audio conferencing capabilities of NetMeeting, on page 2 and the chat feature of page 3), selecting a command to markup the graphical image (taught as the use of selectable drawing tools on a shared Whiteboard, on page 4), and transmitting the markup file across the network to the second client through the chat session (inherent to the program to allow users at different workstations to view edits to the graphical images). Furthermore, NetMeeting teaches markup entities that specify a type of markup to be displayed, taught as the use of a graphic editing toolbar (see the left side of the Whiteboard image) similar to that used by Microsoft Paint. The toolbar clearly allows for different markup entities, such as freeform drawings, text, and geometric objects.

NetMeeting does not explicitly teach in response to the command, storing markup information in a markup file separate from the graphical image, a source reference that identifies

the graphical image, and an orientation that indicates how the graphical image should be displayed with regard to the markup entity.

Schilit teaches a method for maintaining freeform ink annotations similar to those found in NetMeeting. Furthermore, Schilit teaches the separation of annotations from the original display (the annotation database of col. 14, lines 4-8), which are inherently related to an identified source image, and an orientation that indicates how the graphical image should be displayed with regard to the markup entity (taught as the relation of stored annotation strokes and anchor points to their relevant locations on a document, at col. 14, lines 8-49).

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of NetMeeting and Schilit before him at the time the invention was made to modify the markup chat sessions of NetMeeting to include the separation of an original source image with its annotations in order to obtain a chat markup system where annotations are stored separately from their source images.

One would be motivated to make such a combination for the advantage of maintaining the integrity of an original image to be annotated through the use of a transparent markup image, or the possibility of having more than one markup file related to a given image, instead of multiple copies of an original image with annotations, thus conserving storage space.

Regarding claims 2 and 21, NetMeeting teaches storing the graphical image local to the second client, taught as the ability of NetMeeting users to save Whiteboard contents, at page 4.

Regarding claims 3 and 22, it can be seen in the NetMeeting image of page 4 that image markup commands are selectable from a graphic editing menu, and that multiple markup entities are available to markup the graphical image.

Regarding claims 4 and 23, NetMeeting allows for a markup entity to be a second graphical image, taught as the ability to cut, copy, and paste information from any Windows-based application into the Whiteboard, at page 4.

Regarding claims 5 and 24, it can be seen in the NetMeeting image of page 4 that the markup entity may contain text.

Regarding claims 6 and 25, NetMeeting and Schilit do not explicitly teach the use of XML for conveying markup information, including a markup entity tag, a source reference tag, and an orientation tag. However, XML files are well known in the art to give a user the flexibility of tag customization for specific information. The Examiner takes OFFICIAL NOTICE of this teaching. Therefore, it would have been obvious to one of ordinary skill in the art to include an XML file for storing markup information for the advantage of the flexibility offered by the language. Furthermore, any file used to store the annotations of NetMeeting and Schilit separately from the source image itself would inherently contain information pertaining to the markup entities used, the source reference to which the markup entities pertain, and the orientation for the annotations. As XML uses specific tags that enable the formatting of related documents, it would have been obvious for a user to create XML tags specific to the markup entities, source reference, and orientation of the annotations in a separate XML annotation file. See "What is XML?" by Norman Walsh, at <http://www.xml.com/pub/a/98/10/guide1.html#AEN78>.

Regarding claims 7, 8, 26 and 27, it can be seen at NetMeeting page 3 that a single user or multiple users may be specified as the second client in contact with a first client.

Regarding claims 9 and 28, applicant's specification points to XML or other document definition languages as being "firewall friendly" and therefore provide for the transmission of a markup file and text across a network without breaching firewall security measures. Markup information in XML is taught *supra*, and thus provides for the transmission of a markup file and text across a network without breaching firewall security measures.

Regarding claims 10 and 29, the chat feature of NetMeeting (page 3) discloses functionality similar to an instant messaging application, such as the selection of a user or users to send messages to, and the ability to send private messages.

Regarding claim 11, NetMeeting inherently teaches a first client computer and a display device connected to the first client computer. Furthermore, any modern-day computer with storage means is capable of storing a graphical image. NetMeeting shows an instant messaging application installed on a first client computer (the chat capabilities of page 3) and allows for a selectable command to markup a graphical image (the Whiteboard of page 4). Through the use of such chat and Whiteboard capabilities, NetMeeting allows for receiving an identification of a second client to receive the markup file, initializing a chat session across a network with the second client, transmitting the markup file across the network to the second client through the chat session, and displaying the markup entity in the orientation on the graphical image on the display device. Furthermore, NetMeeting teaches markup entities that specify a type of markup to be displayed, taught as the use of a graphic editing toolbar (see the left side of the Whiteboard image) similar to that used by Microsoft Paint. The toolbar clearly allows for different markup entities, such as freeform drawings, text, and geometric objects.

NetMeeting fails to explicitly teach in response to the command, storing markup information in a markup file stored separately from the graphical image, a source reference that identifies the graphical image, and an orientation that indicates how the graphical image should be displayed with regard to the markup entity.

Schilit teaches a method for maintaining freeform ink annotations similar to those found in NetMeeting. Furthermore, Schilit teaches the separation of annotations from the original display (the annotation database of col. 14, lines 4-8), which are inherently related to an identified source image, and an orientation that indicates how the graphical image should be displayed with regard to the markup entity (taught as the relation of stored annotation strokes and anchor points to their relevant locations on a document, at col. 14, lines 8-49).

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of NetMeeting and Schilit before him at the time the invention was made to modify the markup chat sessions of NetMeeting to include the separation of an original source image with its annotations in order to obtain a chat markup system where annotations are stored separately from their source images.

One would be motivated to make such a combination for the advantage of maintaining the integrity of an original image to be annotated through the use of a transparent markup image, or the possibility of having more than one markup file related to a given image, instead of multiple copies of an original image with annotations, thus conserving storage space.

Regarding claim 12, NetMeeting shows the instant messaging application configured to display the markup file in the orientation on the graphical image on the display device in response to receiving the markup file during the chat session, shown as the use of the Whiteboard application between multiple participants, at page 4.

Regarding claim 13, it can be seen in the NetMeeting image of page 4 that image markup commands are selectable from a graphic editing menu, and that multiple markup entities are available to markup the graphical image.

Regarding claim 14, NetMeeting allows for a markup entity to be a second graphical image, taught as the ability to cut, copy, and paste information from any Windows-based application into the Whiteboard, at page 4.

Regarding claim 15, it can be seen in the NetMeeting image of page 4 that the markup entity may contain text.

Regarding claim 16, NetMeeting and Schilit do not explicitly teach the use of XML for conveying markup information, including a markup entity tag, a source reference tag, and an orientation tag. However, XML files are well known in the art to give a user the flexibility of tag customization for specific information. The Examiner takes OFFICIAL NOTICE of this teaching. Therefore, it would have been obvious to one of ordinary skill in the art to include an XML file for storing markup information for the advantage of the flexibility offered by the language. Furthermore, any file used to store the annotations of NetMeeting and Schilit separately from the source image itself would inherently contain information pertaining to the markup entities used, the source reference to which the markup entities pertain, and the orientation for the annotations. As XML uses specific tags that enable the formatting of related documents, it would have been obvious for a user to create XML tags specific to the markup entities, source



reference, and orientation of the annotations in a separate XML annotation file. See "What is XML?" by Norman Walsh, at <http://www.xml.com/pub/a/98/10/guide1.html#AEN78>.

Regarding claims 17 and 18, it can be seen at NetMeeting page 3 that a single user or multiple users may be specified as the second client in contact with a first client.

Regarding claim 19, applicant's specification points to XML or other document definition languages as being "firewall friendly" and therefore provide for the transmission of a markup file and text across a network without breaching firewall security measures. Markup information in XML is taught *supra*, and thus provides for the transmission of a markup file and text across a network without breaching firewall security measures.

### ***Response to Arguments***

The Examiner has submitted with this Office Action archived copies of the NetMeeting 3 references which the Applicant had previously deemed invalid due to date issues. The references disclose content identical to those previously cited by the Examiner, and have a "content updated" date prior to the filing date of the instant application. Therefore, the Examiner believes the NetMeeting 3 reference to be valid.

Applicant's arguments with respect to claims 1-10, 12-19, and 21-29 have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicant's arguments with respect to claims 3, 13, and 22, the multiple markup entities provided by NetMeeting are to be found in the graphic editing toolbar, and not the menu options section of the Whiteboard window.

In response to Applicant's arguments with respect to claims 6, 16, and 25, as stated above, any file used to store the annotations of NetMeeting and Schilit separately from the source image itself would inherently contain information pertaining to the markup entities used, the source reference to which the markup entities pertain, and the orientation for the annotations. As XML uses specific tags that enable the formatting of related documents, it would have been obvious for a user to create XML tags specific to the markup entities, source reference, and orientation of the annotations in a separate XML annotation file.

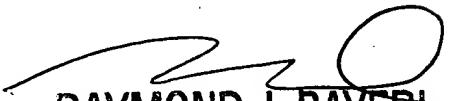
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Roswell whose telephone number is (571) 272-4055. The examiner can normally be reached on 8:30 - 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Roswell  
9/28/2005

  
**RAYMOND J. BAYERL**  
**PRIMARY EXAMINER**  
**ART UNIT 2173**